



30 OCT 2008

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In re Application of:	:	
DIXON, Michael, John, et al.	:	DECISION ON PETITION UNDER
U.S. Application No.: 10/589,684	:	37 CFR 1.47(a)
PCT No.: PCT/GB2005/000320	:	
International Filing Date: 31 January 2005	:	
Priority Date: 20 February 2004	:	
Atty's Docket No.: 9314-0046.00	:	
For: POSITIONER DEVICE	:	

This decision is issued in response to applicants' "Petition For Filing Declaration Under 37 CFR 1.47(a) – Non-Signing Inventor" filed 03 October 2008. Deposit Account No 06-0916 will be charged the required \$200 petition fee.

BACKGROUND

On 31 January 2005, applicants filed international application PCT/GB2005/000320. The international application claimed a priority date of 20 February 2004, and it designated the United States. On 01 September 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 20 August 2006.

On 16 August 2006, applicants' filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 20 March 2008, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an executed declaration in compliance with 37 CFR 1.497, \$420 in additional claims fees, and the surcharge for filing the declaration later than thirty months after the priority date were required.

On 03 October 2008, applicants filed a response to the Notification Of Missing Requirements (with required five-month extension fee). The response included payment of the required additional claims fees and surcharge, a partially executed declaration, and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signature of inventor Terence James HERBERT, whom applicants assert has refused to execute the application.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have authorized a charge to Deposit Account No. 06-0916 for required fees, and the petition states the last known address of the non-signing inventor. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed a declaration executed by one of the two inventors and including an unsigned signature block for the non-signing inventor, Terence James HERBERT. This declaration may be accepted as having been executed by the signing inventor on his own behalf and on behalf of the non-signing inventor. Item (3) is therefore satisfied.

Regarding item (4), MPEP section 409.03(d) states that, before it can be concluded that an inventor has refused to execute the application papers, “[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor’s attorney.” The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, as evidence of the inventor’s refusal to execute the declaration, applicants have provided a declaration of Gary J. Edwards, with accompanying exhibits. These materials indicate that a request for signature, accompanied by a copy of the application, was forwarded to the non-signing inventor at two different last known addresses. However, the statement provides no evidence that the materials were received by the inventor. In fact, the statement indicates that mailings to the two addresses were both returned by the postal service, with indications that “addressee has gone away” (from one of the addresses) and “addressee unknown” (from the other address). Because it does not appear that the inventor received the signature requests forwarded to these apparently outdated addresses, the inventor’s failure to respond to such mailings does not support a conclusion that the inventor has refused to execute the application.

In the alternative, if applicants seek to demonstrate that the non-signing inventor cannot be located, applicants must provide firsthand and documentary evidence demonstrating a diligent effort to identify a current address for the inventor and to contact him at such address. See MPEP section 409.03(d). Any such diligent search should include, but not be limited to, an internet search for the inventor, with the results of such internet search being made of record herein. The present petition includes no evidence that a diligent effort has been made to locate the non-signing inventor.

Based on the above, applicants have failed to provide an acceptable showing that the non-signing inventor has refused to execute the application or cannot be located after diligent effort. Item (4) is not satisfied on the present record.

Based on the above, applicants have failed to satisfy all the requirements of a grantable petition under 37 CFR 1.47(a).

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the additional materials required to satisfy item (4) of a grantable petition, as discussed above and in the MPEP. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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